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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/735,349	12/11/2003	Michael D. Laufer	036565-000018	3758
7590 08/14/2008				
Robert E. Krebs Thelen Reid & Priest LLP P.O. Box 640640 San Jose, CA 95164-0640			EXAMINER STEPHENS, JACQUELINE F	
			ART UNIT 3761	PAPER NUMBER
			MAIL DATE 08/14/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/735,349

**Applicant(s)**

LAUFER ET AL.

**Examiner**

Jacqueline F. Stephens

**Art Unit**

3761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 9/4/07.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 55-60 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 55-60 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/02)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Response to Arguments***

1. Applicant's arguments with respect to claims 55-60 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 55-60 are rejected under 35 U.S.C. 102(b) as being anticipated by Halverson USPN 6071260.
4. As to claims 55 and 56, Halverson teaches a method of removing fatty tissue while protecting nerves, comprising the steps: exposing a portion of said fatty tissue; pressing said fatty tissue with a non-convex surface having at least one hole (Figures 4 and 5; col. 1, lines 56-60; col. 6, lines 1-16); extruding fat through said at least one hole, the hole being dimensioned to allow fat cells to extrude through while preventing nerves from passing therethrough (col. 3, lines 64-65; col. 7, lines 1-4) and cutting said fat that has extruded through said hole on a side of said surface opposite said fatty tissue (col. 1, lines 53-60).

As to claim 58, Halverson teaches heating said fatty tissue at a time selected from the

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group consisting of prior to said cutting step, during said cutting step, and both prior and during said cutting step (col. 2, lines 4-17; col. 3, lines 17-20).

As to claim 59, the step of pressing said fat layer further comprises pressing with a surface having at least one hole located on a distalmost end of a cannula (Figures 4 and 5).

As to claim 60, the step of pressing the fat layer further comprises pressing with a surface having at least one hole located proximal of a distalmost end of a cannula (Figures 4 and 5).

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 55, 56, and 58-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Halverson USPN 6071260.

8. As to claims 55 and 56, Halverson teaches a method of removing fatty tissue while protecting nerves, comprising the steps: exposing a portion of said fatty tissue; pressing said fatty tissue with a non-convex surface having at least one hole (Figures 4 and 5; col. 1, lines 56-60; col. 6, lines 1-16); extruding fat through said at least one hole, the hole being dimensioned to allow fat cells to extrude through while preventing nerves from passing therethrough (col. 3, lines 64-65; col. 7, lines 1-4) and cutting said fat that has extruded through said hole on a side of said surface opposite said fatty tissue (col. 1, lines 53-60).

As to claim 58, Halverson teaches heating said fatty tissue at a time selected from the group consisting of prior to said cutting step, during said cutting step, and both prior and during said cutting step (col. 2, lines 4-17; col. 3, lines 17-20).

As to claim 59, the step of pressing said fat layer further comprises pressing with a surface having at least one hole located on a distalmost end of a cannula (Figures 4 and 5).

As to claim 60, the step of pressing the fat layer further comprises pressing with a

surface having at least one hole located proximal of a distalmost end of a cannula (Figures 4 and 5).

9. Claim 57 is rejected under 35 U.S.C. 103(a) as being obvious over Halverson as applied to claim 55 above in view of Bass US 2003/0176851. Halverson discloses the present invention substantially as claimed. Halverson does not teach cutting fat with an electrocautery element. Bass teaches employing an electrocautery element for the benefits of providing faster and more complete fat removal and well as producing less bruising, less blood, and faster recovery (paragraph 0026). It would have been obvious to one of ordinary skill in the art to modify Halverson with an electrocautery element for the benefits that Bass teaches.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacqueline F. Stephens whose telephone number is (571) 272-4937. The examiner can normally be reached on Monday-Friday 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tanya Zalukaeva can be reached on (571) 272-1115. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jacqueline F Stephens/

Primary Examiner, Art Unit 3761